

REMARKS

Claims 1-22 are pending in this application. Claim 1 has been amended in one instance for purposes of clarity and brevity that are unrelated to patentability and prior art rejections in accordance with current Office policy, to further and alternatively define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

Claims 1, 3, 8-9, 11, 16 and 18 have been rejected under 35 U.S.C. §102(e) as being anticipated by a newly cited art, Knight et al., U.S. Patent No. 6,493,703 for reasons stated on pages 3-5 of the Office Action (Paper No. 8). Applicants submit, however, that the features of Applicants' claims 1, 3, 8-9, 11, 16 and 18 are not disclosed or suggested by Knight '703. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection for the following reasons.

The present invention is directed to an interactive method (software installed in a computer system) and mechanism to automatically find and organize items such as files, emails, tasks, contacts, appointments and web-pages that are similar to example (prototypical) items designated by a user. See independent claims 1, 9 and 17. Such an interactive method and mechanism as generally defined in each of Applicants' independent claims 1 and 9 requires, *inter alia*, providing three different group areas, i.e., related group area, not related group area, and suggestions group area, for an organization instance; receiving at least one example item for an organization instance designated by a user ... placed in [a] related group area; searching a database to locate at least one item which is related to at least one item in said related group area based on a predetermined criterion, and placing located

items in [a] suggestions group area; modifying said predetermined criterion based on at least one of the user providing at least one additional example item and the user moving an item from one of said group areas to another of said group areas; and continually searching said database to locate and place additional items in said suggestions group area which are related to said at least one item in said related group area based upon said modified predetermined criterion.

In other words, such an interactive method and mechanism of Applicants' claims 1 and 9 is able to allow the user to group or designate one or more example (photo-typical) items in a related group area in order to search (via query) a database and provide suggestions for items that are "similar" to the one or more example items in the related group area, and interact with the search result to refine the example items.

In contrast to Applicants' claims 1 and 9, Knight '703 discloses an online message board service, as shown in FIG. 2, using an intelligent data collection and indexing system to collect, review and analyze posting and query entries by user, so that information from the same can be polled, tabulated, indexed and presented in forms that are of interest to the users. Specifically, a server 220 is provided with content extract/posting robots 230 used by the service provider to construct content information before the message board system is open for users; community search robots 231 used to compile and index useable contents for the community; customized search robots 232 used to create logical collections of messages based on individual user filtering criteria; user posting robots 235 used to allow the users to define and automatically create content subject matter areas that are of interest to

such users; and a database management routine 240 responsible for coordinating data storage and retrieval operations.

The content subject matter areas are broken down into class and sub-classifications as desired, and then stored in indices 261. Because entries are already indexed according to predefined subject matter area/class/subclass indices 261, a group of the same matching the user's query criteria can be easily and rapidly located. Entry request from a user is shown in FIG. 3A. A screen appearance at the user's Internet Browser is shown in FIG. 3B, including subject matter area control button 312 which allows the user to identify an initial broad area of search for a group of related messages; a first display area 315 with a more detailed subject matter area menu 316 and message query filter parameters 317 in an expandable tree format (known as "tree-structured menu") to allow the user to visualize all possible selections without having to perform time consuming scrolling operations.

Again, the information that is available for users in such an online electronic message system is broken down and sorted into a number of subject matter areas, which subject matter areas represent logical collections of content according to a set of service provider specific rules, filters, and criteria.

However, the online data service as described by Knight '703 does **not** "automatically find and organize data items similar to example items provided by a user" in the manner described in Applicants' disclosed invention and expressly defined in Applicants' independent claims 1 and 9. There is **no** provision anywhere in the online data service system of Knight '703 for the three different group areas, i.e., related group area (see item 150, FIG. 1), not related group area (see item 160,

FIG. 1), and suggestions group area (see item 120, FIG. 1) for an organization instance as expressly defined in Applicants' independent claims 1 and 9, such that, when a data item for such an organization instance provided by the user is received and placed in the related group area, the database is searched to locate at least one data item that is related to the data item placed in the related group area based on a predetermined criterion, and place located data items in the suggestions group area. Likewise, there is no disclosure any "modifying [a] predetermined criterion based on the user providing at least one additional data item and moving a data item from one group area into another group area, so that the database is continually searched and additional data items in the suggestions group area can be located and then placed in the related group area.

Nevertheless, the Examiner cites column 6, lines 49-59 and column 26, lines 9-27 of Knight '703 for allegedly disclosing the feature "providing related, not related, and suggestions group areas for an organization instance, each of these areas to contain items" as defined in each of Applicants' claims 1 and 9.

However, the citation is misplaced. The cited column 6, lines 49-59 of Knight '703 simply refers to the use of a sorting mechanism used by the online data service to sort information into one or more categories in a classification scheme. For example, as described on column 10, lines 7-15 of Knight '703, the information can be divided into groups such as (1) stock trading related information (i.e., stock price, patterns, fundamentals and the like); (2) product related information; (3) marking related information; (4) sales/financial information; (5) author/source; (6) date etc.

Such a classification scheme does not and cannot be interpreted to read on Applicants' claimed "providing related, not related, and suggestions group areas for an organization instance, each of these areas to contain items" as defined in each of Applicants' claims 1 and 9.

Similarly, the Examiner cites column 10, lines 15-23 of Knight '703 for allegedly disclosing the feature "searching a database to locate at least one item which is related to at least one item in said related group area based on a predetermined criterion, and placing located items in said suggestions group area" as defined in Applicants' independent claims 1 and 9.

Again, the citation is misplaced. The cited column 10, lines 15-23 of Knight '703 simply refers to the data management process that is dynamic, iterative and continuous, so that a number of community/custom search robots 231-232, as shown in FIG. 2, may be simultaneously parsing database 270 to create, update or remove the associated subject matter area/class/subclass indices.

Again, such data management process does not and cannot be interpreted to read on Applicants' claimed "searching a database to locate at least one item which is related to at least one item in said related group area based on a predetermined criterion, and placing located items in said suggestions group area" as defined in Applicants' independent claims 1 and 9. This is because the online data service of Knight '703 does not make a distinction between a related group area, a not-related group area and a suggestions group area, and hence, data movement from one group area into another group area.

Likewise, the Examiner cites column 15, lines 19-48 of Knight '703 for allegedly disclosing the feature "continually searching the database to locate and place additional items in the suggestions group area which are related to the at least one item in the related group area based on the modified predetermined criterion" as defined in Applicants' independent claims 1 and 9.

Again, the citation is misplaced. The cited column 15, lines 19-48 of Knight '703 simply refers to the more detailed subject matter area menu 316 and message query filter parameters 317 in an expandable tree format (known as "tree-structured menu") to allow the user to visualize all possible selections without having to perform time consuming scrolling operations.

Again, such subject matter menu according to Knight '703 does not and cannot be interpreted to read on Applicants' claimed "continually searching the database to locate and place additional items in the suggestions group area which are related to the at least one item in the related group area based on the modified predetermined" as defined in Applicants' independent claims 1 and 9.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051

(Fed. Cir. 1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, Knight '703 fails to disclose and suggest features of Applicants' independent claims 1 and 9, and features of their respective dependent claims 3, 8, 11, 16 and 18. Therefore, Applicants respectfully request that the rejection of claims 1, 3, 8-9, 11, 16 and 18 be withdrawn.

Claims 2, 10 and 17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Knight '703, in view of another newly cited art, Zhai, U.S. Patent No. 6,463,434. In support of this rejection, the Examiner assumes that the §102 rejection of claims 1, 3, 8-9, 11, 16 and 18 is correct, and asserts that Knight '703 discloses all aspects of Applicants' claims 2, 10 and 17, except for the feature "assigning a normalized relevance score for each item based on each item's

relevance to the at least one item in the related group area and wherein located items having a relevance score greater than a predetermined threshold are placed in the suggestions group area" which is alleged disclosed or suggested on column 2, lines 55-62 and column 4, lines 25-32 of Zhai '434.

This rejection is respectfully traversed, however. Notwithstanding the fact that the correctness of this rejection is predicated upon the correctness of the §102 rejection of claims 1, 3, 8-9, 11, 16 and 18, which Applicants have pointed out as being incorrect, the cited column 2, lines 55-62 and column 4, lines 25-32 of Zhai '434 only refer to the user profile score threshold setting and updating according to the relevance of the documents. There is **no** teaching or suggestion anywhere in Zhai '434 of Applicants' claimed "assigning a normalized relevance score for each item based on each item's relevance to the at least one item in the related group area and wherein located items having a relevance score greater than a predetermined threshold are placed in the suggestions group area", that is, in the context of the three group areas, i.e., related group area, not related group area and suggestions group area.

The law under 35 U.S.C. §103 is well settled that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." ACS Hospital System, Inc v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner must point to something in the prior art that suggests in some way a modification of a particular reference or a combination of references in order to arrive at Applicants' claimed invention. Absent

such a showing, the Examiner has improperly used Applicants' disclosure as an instruction book on how to reconstruct to the prior art to arrive at Applicants' claimed invention. This is in addition to the requirement that the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination must be found in the prior art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. In other words, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USQP 494, 496 (CCPA 1970).

In the present situation, Knight '703 and Zhai '434 fail to disclose and suggest features of Applicants' claims 2, 10 and 17. Therefore, Applicants respectfully request that the rejection of claims 2, 10 and 17 be withdrawn.

Claims 4-6, 12-14 and 19-21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Knight '703, in view of Geary, U.S. Patent No. 6,070,160. In support of this rejection, the Examiner also assumes that the §102 rejection of claims 1, 3, 8-9, 11, 16 and 18 is correct, and asserts that Knight '703 discloses all aspects of Applicants' claims 4-6, 12-14 and 19-21, except for the feature "the user selectively moves an item from one group area to another group area via the user interface by moving a visual representation of the item from a visual representation of the one group area to a visual representation of another group area" which is alleged disclosed or suggested on column 42, lines 36-48 of Geary '160.

This rejection is respectfully traversed, however. Notwithstanding the fact that the correctness of this rejection is predicated upon the correctness of the §102 rejection of claims 1, 3, 8-9, 11, 16 and 18, which Applicants have pointed out as being incorrect, the cited column 42, lines 36-48 of Geary '160 does not disclose what the Examiner alleges.

Geary '160, as a secondary reference, only discloses a computer system as shown in FIG. 3 having a program 200 configured for searching works that are non-deterministic and subjective in nature, such as art, music, film, dance, theatre and other subjective work in such a way that a customer may locate an art work, for example, according to limited information such as an artist's name, a certain style etc. According to Geary '160, a series of search engines as shown in FIG. 12 are programmed to rely on both deterministic and fuzzy logic, and search terms are adapted by methods such as exchange them synonyms, truncation, swapping information between fields searched, searching by key words, use of complex indices to rapidly move between different databases, and to broaden the scope of a search and to find elusive relationships between otherwise unrelated fields in different databases, and to selective ignore or modify search terms that narrow a search excessively.

Geary '160 does **not** disclose "receiving at least one example item for the organization instance provided by a user, the at least one example item being placed in the related group area." Geary '160 does **not** disclose provide different group areas for an organization instance, i.e., a related group area, a not-related group area and a suggestion group area as alleged by the Examiner. As a result, there is

no disclosure of any moving a data item from one group area into another group area as suggested by the Examiner.

In view of the foregoing deficiencies the proposed combination of Knight '703 and Geary '160, Applicants respectfully request that the rejection of claims 4-6, 12-14 and 19-21 be withdrawn.

Lastly, claims 7, 15 and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Knight '703, in view of Pickering, U.S. Patent No. 6,493,695. In support of this rejection, the Examiner also assumes that the §102 rejection of claims 1, 3, 8-9, 11, 16 and 18 is correct, and asserts that Knight '703 discloses all aspects of Applicants' claims 7, 15 and 22, except for the feature "each of the items indicates one of a file, an email, and a mail item such as a task, contact information and a web page" which is alleged disclosed or suggested on column 3, lines 37-53 of Pickering '695. Again, this rejection is respectfully traversed for the same reasons discussed against the §102 rejection of claims 1, 3, 8-9, 11, 16 and 18.

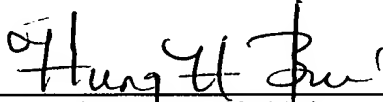
In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC area office at (703) 312-6600.

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Respectfully submitted,

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A handwritten signature in cursive script, appearing to read "Hung H. Bui", is written over a horizontal line.

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